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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,608	11/24/2003	Joseph J. Massad	M3330.003	4237

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HEAD, JOHNSON & KACHIGIAN
228 W 17TH PLACE
TULSA, OK 74119

EXAMINER

WILSON, JOHN J

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/720,608

Applicant(s)

MASSAD, JOSEPH J.

Examiner

John J. Wilson

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 1-5, 7 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/24/03.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

In view of applicant's amendment of June 22, 2006, the restriction requirement is modified below.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5 and 8, drawn to a method for establishing balanced occlusion and product-by-process, classified in class 433, subclass 68.
- II. Claims 6 and 9, drawn to a special tooth and central bearing device, classified in class 433, subclass 202.1 and 69.
- III. Claim 7, drawn to central bearing device, classified in class 433, subclass 69.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the special tooth of group II can be used in a method different than that of group I, in that it can be used in a method of forming a temporary tooth.

Inventions I and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus

as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the method of group 1 does not require the central bearing pin and flanges of group III, and/or, the group III device can be used for measuring jaw movement.

Inventions III and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because it does not require the central bearing pin and flanges of group III. The subcombination has separate utility such as balancing dentures that do not include receptacles filled with resin.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Applicant's election with traverse of the Group II invention, claims 6 and 9, in the reply filed on June 22, 2006 is acknowledged. The traversal is on the ground(s) that all of the claims could be simply and easily considered together. This is not found

persuasive because the inventions are different for the reasons given above, and the degree of difficulty in considering the claims is merely a matter of opinion.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-5, 7 and 8 stand withdrawn from further consideration.

An action on the merits of elected claims 6 and 9 follows.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 6 is rejected under 35 U.S.C. 102(b) as being anticipated by Worthington (6068481). Worthington shows a tooth 320, Figs. 17-24, having sides 324, 326, 330, a receptacle 353 and the curved top part of the tooth shown in the figures, that are filled with resin, column 6, lines 32-45 and column 6, lines 1-6, in the form of an occlusal surface. The claim uses the term "receptacle" which, in the embodiment shown in the present drawings, has a bottom, however, this term is not specifically defined in the specification, and as such, is given its normal meaning, which is, something that holds or contains, and as such, the claim language is properly met by Worthington which holds and contains the resin as taught. That the shown tooth of Worthington may be for insertion into a dental prosthesis is merely intended use, all of the actual claimed structure being shown, the intended use is given no patentable weight.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Worthington (6068481) in view of Opatow (2309270). Worthington shows a tooth 320, Figs. 17-24, having sides 324, 326, 330, a receptacle 353 and the curved top part of the tooth shown in the figures, that are filled with resin, column 6, lines 32-45 and column 6, lines 1-6, in the form of an occlusal surface. The claim uses the term "receptacle" which, in the embodiment shown in the present drawings, has a bottom, however, this term is not specifically defined in the specification, and as such, is given its normal meaning, which is, something that holds or contains, and as such, the claim language is properly met by Worthington which holds and contains the resin as taught. That the shown tooth of Worthington may be for insertion into a dental prosthesis is merely intended use, all of the actual claimed structure being shown, the intended use is given no patentable weight. Worthington does not show a central bearing device. Opatow shows a central bearing device, Fig. 1. It would be obvious to one of ordinary skill in the art to modify Worthington to include a central bearing device as shown by Opatow because the claim is merely a list of separate elements, not structurally tied together, that are intended to be used together, and as such, a list of the same elements by the

prior art properly meets all of the claimed structure. The intended use of these elements together is not given patentable weight.

Drawings

The drawings submitted November 24, 2003 are objected to by the examiner because the shading used is not clearly shown and because of hand drawn numerals and lead lines.

Specification

The Abstract should be checked to insure that it is reflective of the current claimed invention.

Information Disclosure Statement

The IDS filed November 24, 2003 has been considered and an initialed copy attached.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Baumgardner (2574810), Faust et al (3826002), Laszlo (4608020) and Spiry (4778386) show receptacles.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Wilson whose telephone number is 571-272-4722). The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver, can be reached at 571-272-4720). The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John J. Wilson
Primary Examiner
Art Unit 3732

jjw
August 22, 2006